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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,514	02/28/2002	Christoph Gurtler	Mo6801/LcA 34,953	8714

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EXAMINER

PUTTLITZ, KARL J

ART UNIT	PAPER NUMBER
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1621

DATE-MAILED: 01/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/085,514

Applicant(s)

GURTLER ET AL.

Examiner

Karl J. Puttlitz

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The previous ground of rejection under this section is withdrawn.

Claims 1-21 are newly rejected under this section. In this regard, the claims, as amended, recite that a carboxylic acid compound *consisting essentially of* aliphatic carboxylic acids, aromatic carboxylic acids and or mixtures thereof. The use "consisting essentially of" in this context renders the claims indefinite because it is unclear what aliphatic or aromatic carboxylic acids are intended.

Claim Rejections - 35 USC § 103

Remarks under this section set forth in the previous Office Action are incorporated herein by reference.

Applicant's arguments filed October 20, 2003 have been fully considered but they are not persuasive.

The rejection to claims 1-7, 11-17 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,580,947 to Brahm et al. (Brahm) is maintained. Specifically, Applicant argues that the olefinically unsaturated carboxylic acids taught by Brahm do not meet the limitation of a carboxylic acid compound consisting essentially of aliphatic carboxylic acids, aromatic carboxylic acids and or mixtures thereof. The examiner disagrees. Specifically, the specification explains that unsaturated carboxylic acids may

also be used. In addition, aromatic carboxylic acids, such as benzene tetracarboxylic acid, may be used. See column 4, line 35. Given the broadest reasonable interpretation consistent with the specification, Brahm teaches the claimed carboxylic acids.

Applicant also argues that the "laundry list" of catalysts disclosed by Brahm does not reasonably lead one of ordinary skill to the claimed catalyst. However, Brahm, teaches the claimed catalyst with sufficient guidance, particularity, and with a reasonable expectation of success, that any of the disclosed catalyst would be *prima facie* obvious to one of ordinary skill. See M.P.E.P. § 2143.

The rejection of claims 1-21 under 35 U.S.C. 103(a) as being unpatentable over U.S. patent No. 3,970,600 to Falkenstein et al. (Falkenstein) in view of Brahm is maintained.

Applicant argues that the combination fails because Brahm teaches catalyst useful for olefinically unsaturated reactants, not those recited in the claimed invention. See Response page 9. However, as stated above, Brahm teaches the claimed carboxylic acids. Accordingly, one of ordinary skill would be motivated to use the claimed catalyst with the claimed carboxylic acid reactants based on Brahm.

The rejection to claims 1-21 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,616,061 to Henning et al. (Henning) is maintained.

Again, Applicant argues that the combination fails because Brahm teaches catalyst useful for olefinically unsaturated reactants, not those recited in the claimed invention. See Response page 11. However, as stated above, Brahm teaches the claimed carboxylic acids. Accordingly, one of ordinary skill would be motivated to use the claimed catalyst with the claimed carboxylic acid reactants based on Brahm.

The rejection of claims 1, 2, 11 and 12 under 35 U.S.C. 103(a) as being unpatentable over JP 6-172518 (abstracts from JPO and DERWENT copy enclosed), hereinafter "JP 518") is maintained.

Again, Applicant argues that the combination fails because Brahm teaches catalyst useful for olefinically unsaturated reactants, not those recited in the claimed invention. See Response page 11. However, as stated above, Brahm teaches the claimed carboxylic acids. Accordingly, one of ordinary skill would be motivated to use the claimed catalyst with the claimed carboxylic acid reactants based on Brahm.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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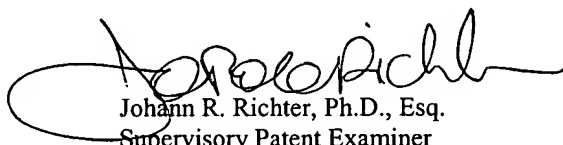
mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl J. Puttlitz whose telephone number is (703) 306-5821. The examiner can normally be reached on Monday-Friday (alternate).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (703) 308-4532. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Karl J. Puttlitz
Assistant Examiner


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